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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,970	07/11/2003	Satoshi Kidooka	P23559	2858
7055 7590 06/13/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER VRETTAKOS, PETER J	
			ART UNIT 3739	PAPER NUMBER
			NOTIFICATION DATE 06/13/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/616,970	Applicant(s) KIDOOKA, SATOSHI	
	Examiner Peter J. Vrettakos	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10-17, 19, 20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 10-17, 19, 20 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3-7-7; 10-14-3</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-5, 7-8, 10-17, 19-20 and 22-25 are rejected below. Claims 1 and 19 are independent.

RCE filed 4-23-07.

The action is non-final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 10, 11, 13-17, 19-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marucci et al. (6,582,451) in view of Schmaltz et al. (6,050,996) and further in view of Slater et al. (5,482,054).

Marucci neglects to expressly disclose manipulation members comprising electrodes and dual purpose (electrical and mechanical) electrical conductors.

Note: patented electrosurgical forceps makes obvious leads connecting to positive and negative terminals of a frequency power supply.

Independent claims 1,19 (parentheticals refer to Marucci)

A treatment tool (see figure 1a – *the rejection relies heavily upon this figure*) to be inserted into a human body through an endoscope (col. 1:20-25) comprising:

an elongated inserting portion (13) to be inserted through an accessory channel of the endoscope;

a supporting member (11) attached to a distal end of said inserting portion, said supporting member being provided with a slit (depicted at 74 in figure 1a);

a shaft (28, better depicted but not enumerated in figure 1c) attached (through the holes adjacent element 74 in figure 1a) to said supporting member so as to cross said slit in a width direction thereof (depicted figure 1b);

a pair of manipulation members (12, 12) at least one of said pair of manipulation members being pivotably supported by said shaft within said slit (depicted in figure 1g, *inter alia*) so as to open and close with respect to another of said pair of manipulation members like a pair of pincers ("jaws"), said pair of manipulation members comprising a pair of electrodes (see col. 6:33-40 for a disclosure of jaw members and associated modalities strongly related to electrode use such as radiofrequency and unipolar/bipolar electrocautery); and

a spacer (constituted by elements 24-25) located between said pair of manipulation members,

wherein said shaft (28) is supported by said spacer (24-25) so as not to come off from said supporting member.

19. A treatment tool configured to be inserted into a human body through an endoscope (col. 1:20-25), said treatment tool comprising: an elongated insertion portion configured to be inserted through an accessory channel of the endoscope; a supporting member (11) attached to a distal end of said inserting portion, said supporting member having a longitudinally extending slit (74);

a shaft (28) attached to said supporting member so as to extend across said slit in a width-wise direction;

a manipulation member (12), pivotally supported (see cross hairs at 28 in figure 3e) by said shaft so as to pivot about said shaft between opened (figure 1e) and closed (figure 1g) positions with respect to another manipulation member; and

a spacer (24-25) fixedly positioned with respect to said supported member within said slit (74), said spacer located between said manipulation member and said another manipulation member (two element 12s) and supporting said shaft (28).

Schmaltz et al. discloses analogous forceps (10) with jaws/manipulation members (19,20) with RF electrodes (11,12).

Slater et al. discloses dual-purpose electrical conductors (pull wires disclosed in the last two sentences in the abstract).

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Marucci in view of Schmaltz and further in view of Slater by including as a design expedient jaw/manipulation members (Marucci 12) comprising electrodes (Schmaltz 11,12) in light of the disclosure in Marucci col. 6:33-40

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where RF and electrocautery are disclosed, and dual-purpose electrical conductors.

The commonsensical motivation would be to create a device capable of performing through electrodes its disclosed (in Marucci) intended use (RF, electrocautery) and to provide an additional function (mechanical) to electrical conductors.

Dependent claims

2. The treatment tool according to claim 1, wherein said shaft (28) is pressed (depicted in figure 1e) into said spacer (24-25). Note the corresponding hole into which element 28 rests is depicted but not enumerated figure 1b).

3. The treatment tool according to claim 2, wherein said spacer (24-25) is provided with a through hole (depicted and enumerated –28- in figure 1a) having an inner diameter smaller than an outer diameter of said shaft (inherent for shaft to rest securely in through hole), said shaft being pressed (again, inherent) into said through hole.

4. The treatment tool according to claim 1, comprising a pair of said shafts (28 and 26 – figure 1a), both of said shafts being pressed into said spacer (24-25), each of said pair of manipulation members (12) being pivotably mounted to respective one of said shafts so as to open and close like a pair of pincers (“jaws”).

5. The treatment tool according to claim 4, wherein said spacer (24-25) is provided with a pair of through holes (figure 1a, element 28 and the non-enumerated proximal and

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longitudinally parallel hole) formed in parallel to each other, each of said through holes having an inner diameter smaller than an outer diameter of each of said shafts (26,28) (inherent for shaft to rest securely in through hole), said shafts being pressed (again, inherent) into respective one of said through holes.

7. The treatment tool according to claim 6, wherein said spacer is made of poly-tetra-fluoro-ethylene. See col. 12:35-41. The disclosure of atraumatic plastic anticipates poly-tetra-fluoro-ethylene, an atraumatic plastic.

9. The treatment tool according to claim 6, wherein said manipulation members (12; "jaws") are connectable to a high frequency power supply. See col. 6:33-40 for a disclosure of jaw members and associated modalities strongly related to connections to high frequency power supplies such as unipolar/bipolar electrocautery.

10. The treatment tool according to claim 1, wherein said supporting member (11) is made of insulating material. See col. 12:35-41 – plastic = insulating material.

11. The treatment tool according to claim 10, wherein said supporting member (11) is made of rigid plastic. See col. 12:35-41.

13. The treatment tool according to claim 1, wherein said shaft (28) engages

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said supporting member (11), said spacer (24,25) and one of said manipulation members (12). See figure 1g.

14. The treatment tool according to claim 1, wherein said pair of manipulation members are configured to rotate (see cross hairs at 28 in figure 3e inferring pivot/rotation) about said shaft.

15. The treatment tool according to claim 1, wherein said spacer is fixedly positioned with respect to said supporting member. Addressed below in Response to Arguments section.

20. The treatment tool according to claim 19, said manipulation member and said another manipulation member comprising conductive electrodes. Addressed above in part of rejection toward claim 1.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marucci et al. (6,582,451) in view of Schmaltz et al. (6,050,996) and further in view of Slater et al. (5,482,054) and even further in view of Mayenberger (5,853,412).

Marucci/Schmaltz/Slater is silent concerning ceramics.

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Mayenberger discloses in an invention analogous to Marucci, ceramic parts (insulating by design). See Mayenberger claims 5 and 8.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Marucci in view of Schmaltz et al. (6,050,996) and further in view of Slater et al. (5,482,054) and even further in view of Mayenberger (5,853,412) by including as a commonsensical design expedient ceramic parts for their insulating properties (motivation) as disclosed in Mayenberger.

Response to Arguments

Applicant's arguments filed 4-23-07 have been fully considered but they are not persuasive.

Marucci, Schmaltz and Slater are analogous as all three disclose electrosurgical forceps/graspers, which the Patent Office views under the same rubric. See subclass 606/51. Schmaltz is classified in 606/51, Slater could very easily be cross classified in 606/51 as electrosurgical forceps, and Marucci in conjunction with the explicit suggestion (col. 6:33-40) to add the platforms to the jaw members for diagnostic or therapeutic modalities including, but not limited to: radiofrequency, unipolar and bipolar electrocautery, could be easily cross classified in 606/51. (Note: these suggested jaws with platforms would be electrodes, easily and fairly assigned in the rejection above as "manipulation members comprising a pair of electrodes" as claimed. The Applicant is

respectfully reminded that rejections are not *ipsissimis verbis* tests and therefore the prior art need not disclose verbatim the claimed elements.)

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, in *Dystar Textilfarben v. C.H. Patrick*, 464 F.3d 1356, (10-3-2006) the federal circuit held that this "motivation to combine" or "suggestion test" requirement is not a rigid categorical rule as many may have previously believed. That is, there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention. Rather, as stressed by the court, "the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art." This knowledge may include common knowledge or simply the nature of the problem. After restating the bounds of the suggestion test, the court found that a higher level of skill was indeed needed to appreciate the teaching in the patent. The court also scolded DyStar and other "commentators" for improperly interpreting prior cases as requiring explicit teaching to combine in the prior art. According to the federal circuit, the flexibility of the suggestion test is completely within Supreme Court jurisprudence. To this end, notwithstanding any alleged absence of express disclosure of motivation to

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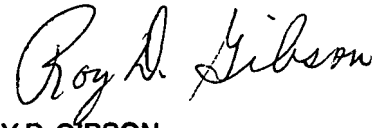

combine the prior art above, the Office believes a commonsensical motivation exists to combine to prior art, establishing the fact that their combinations make obvious the Applicant's claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
May 31, 2007



ROY D. GIBSON
PRIMARY EXAMINER